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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|--------------------------|---------------------|------------------|
| 09/653,732 | 09/01/2000 | Andrew Joseph Paszkowski | 011916.107912 | 5800 |

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TROUTMAN SANDERS LLP
BANK OF AMERICA PLAZA, SUITE 5200
600 PEACHTREE STREET, NE
ATLANTA, GA 30308-2216

EXAMINER

BARRY, CHESTER T

ART UNIT PAPER NUMBER

1724

DATE MAILED: 05/19/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/653,732

Applicant(s)

PASZKOWSKI, ANDREW JOSEPH

Examiner

Chester T. Barry

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 18-20, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 18-20, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 May 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

The specification is objected to under 35 USC §132 for the addition of new matter into the application. The change in the specification from "80 nanometers" to "500 nanometers" is "new matter" because there is no evidence suggesting to the skilled artisan that this particular applicant understood that "silica particles" could be as large as 500 nanometers without settling out. Whether the hypothetical person of ordinary skill in the art knew this to be the case is irrelevant. So applicant's citation to USP 5352277 to Sasaki or to a chemical dictionary is not well taken. The issue is not whether skilled artisans knew that the 80 nanometer cut-off was on the order of an order of magnitude too low (assuming 500 is a more accurate figure than 80 nm). The issue is what the skilled artisan would have understood this applicant to have been in possession of based on his application as originally filed. Insofar as the claimed invention is defined in part by "colloidal silica" and that term is defined by applicant in terms of silica particle size set at 8 – 80 nm, the issue presented here rises to more than just whether 8 – 80 nm is the "factually correct" size range of colloidal silica particles: By virtue of applicant's definition, it goes to the very heart or essence of what the skilled artisan would have understood applicant to have been in possession of. The new matter must be removed from the specification.

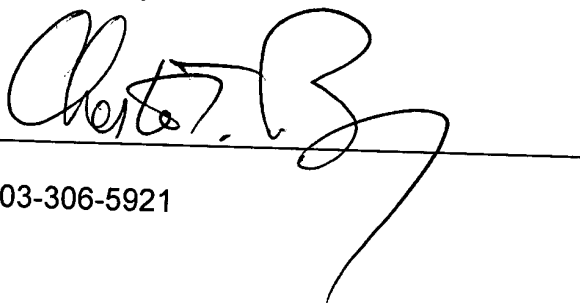
Claims 1 – 9 and 18-20, 23-24 are rejected under 35 USC 112(1st paragraph) insofar as the claimed invention is not supported by the original application. Specifically, given the broadening of the range of silica particle sizes that do not settle from 8 – 80 nm to 8 – 500 nm, the claims now encompass subject matter which the

skilled artisan would not have understood applicant to have been in possession of (i.e., silica colloids having silica particles in the (8 – 500 nm range) based on an original reading of applicant's specification, i.e., colloidal silica with silica particles of the 8 – 80 nm size range.

While applicant's amendment may not have been filed to overcome a rejection based on prior art, the examiner notes: 1) The examiner made certain §112, second paragraph rejections; 2) thereafter, Applicant amended claims to overcome the §112, second paragraph, rejections, and 3) §112, second paragraph, is a statutory provision that is substantially related to patentability. Festo.¹

The art rejections previously applied are withdrawn in light of applicant's amendments to the claims.

Respectfully,

A handwritten signature in black ink, appearing to read "Chestert T. Barry", is written over a horizontal line. The signature is stylized with a large, looping "B" at the end.

703-306-5921

CHESTERT T. BARRY
PRIMARY EXAMINER

¹ Citation available upon request. If needed, please contact the examiner at 703-306-5921.